

REMARKS

Claims 12-16 and 20-22 are pending in this application. By this Amendment, claim 13 is amended to overcome the rejection under 35 U.S.C. §112, second paragraph. Claim 16 is amended to overcome the claim objection and correct a minor typographical error. Claims 17-19 are canceled. No new matter is added by this Amendment.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration (as the amendments merely address formality issues); (c) satisfy a requirement of form asserted in the previous Office Action (see claims 13 and 16); (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to the forms requirements asserted in the Final Rejection. Entry of the amendments is thus respectfully requested.

I. Interview

The courtesies extended to Applicants' representative by Examiner Higgins and Examiner Shosho at the interview held October 29, 2008 are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicants' record of the interview.

II. Claim Objections

Claims 16 and 19 were objected to because the phrase "an atomic percentage of" was allegedly awkward and should not have been included in the claims. Although Applicants respectfully disagree with the Patent Office's conclusion, Applicants have deleted the phrase "an atomic percentage of" from claim 16. Furthermore, claim 19 has been canceled.

Withdrawal of the objection is respectfully requested.

III. Rejection Under 35 U.S.C. §112, Second Paragraph

Claim 13 was rejected under 35 U.S.C. §112, second paragraph on the grounds that the "consisting of" language in independent claim 12 allegedly rendered claim 13 indefinite because claim 13 includes "comprising" language. Although Applicants respectfully disagree with the Patent Office's conclusion, Applicants have removed the "comprising" language in claim 13, and replaced it with "consisting of" claim language.

Withdrawal of the rejection is respectfully requested.

IV. Rejections Under 35 U.S.C. §103(a)

A. Claims 12-14 and 17-20

Claims 12-14 and 17-20 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 4,405,706 ("Takahashi"). Applicants respectfully traverse this rejection.

During the interview, Examiner Higgins stated that Takahashi's disclosure of the preferred metals (including Zn and Te), among seven "preferred" metals (see Takahashi, col. 3, lines 52-58), allegedly would have provided one of ordinary skill in the art with a reason or rationale to have selected Zn and Te from the preferred list of metals and to have formed a bimetal alloy therefrom for a recording layer. Furthermore, the Patent Office acknowledged that Takahashi does not disclose the specific atomic percentages recited in claims 12 and 13. However, the Patent Office further alleges that it would have been within the knowledge of one of ordinary skill in the art to have optimized the atomic percentages of Zn and Te in the Zn-Te alloy allegedly suggested by Takahashi. Applicants respectfully disagree.

Applicants respectfully submit that the Patent Office's reasoning is clearly based on impermissible hindsight in view of Applicants specification. In order to have arrived at the subject matter recited in the present claims, one of ordinary skill in the art would have first had to pick a bimetal alloy (as opposed to a single component metal, a three component alloy,

and the like), then would have had to have selected Zn and Te as the two components for the bimetal alloy, and then still further would have to have chosen Zn and Te to be present in the recited amounts. These selections are not indicated in Takahashi, and thus are clearly based solely on the Patent Office's selective hindsight of "picking and choosing" from the Takahashi disclosure. Such "picking and choosing" is clearly based on impermissible hindsight in view of Applicants' specification.

Takahashi does not describe an active layer comprised of a bimetal alloy. Takahashi merely identifies 38 different metals (including Zn and Te) that may be included in a heat mode recording layer "individually or in combination." See Takahashi, col. 3, lines 52-55. Takahashi further identifies 7 "preferred metals" (including Zn and Te). See Takahashi, col. 3, lines 56-58. However, Takahashi does not describe combining any of the listed metals into a bimetal alloy, and thus would not have provided one of ordinary skill in the art with any reason or rationale to have selected two metals from either of the lists in Takahashi.

Furthermore, even if Takahashi could be viewed as describing a bimetal alloy, Takahashi does not describe Zn-Te in combination in a bimetal alloy. Takahashi merely identifies Zn and Te as "preferred metals" among several other metals including Mg, Al, In, Sn and Bi that may be included in a heat mode recording layer. See Takahashi, col. 3, lines 57-58. As such, Takahashi does not describe selecting Zn and Te only from the "preferred metal" list to form a bimetal alloy, and would not have provided one of ordinary skill in the art with a reason or rationale to have formed a heat mode recording medium using a bimetal alloy of Zn and Te.

Furthermore, this is also not a situation where an "obvious to try" rationale supports the rejection. As explained in MPEP §2143E, the "obvious to try" rationale requires a finding that there was a finite number of identified, predictable potential solutions to a recognized need or problem. As was discussed above, this is not a situation where Takahashi describes a

finite number of solutions, but a large number of possible combinations. Even if one used the "preferred metals", Takahashi describes (1) a one component, (2) a two component, (3) a three component, (4) a four component, (5) a five component, (6) a six component and (7) a seven component material as possible combinations, which is approximately 100 possible combinations or more. Thus, it is not possible to find that there was a finite number of identified, predictable potential solutions to a recognized need or problem. Accordingly, the "obvious to try" rationale also cannot be used to support the rejection of claims 12-14 and 17-20 relying upon Takahashi.

Even further, Takahashi also does not describe an active layer comprised of a Zn-Te alloy in the recited Zn and Te amounts. Thus, even if it could be determined that Takahashi somehow would have led one to a bimetallic alloy of Zn and Te, Takahashi at best would have indicated a 50/50 composition of Zn and Te. There is no reason or rationale provided in Takahashi to have varied the ratio of Zn and Te in the Zn-Te alloy at all. Takahashi also provides no indication that the ratio of Zn and Te is a result-effective variable, and thus no basis to assert that one would have found it obvious to have varied the Zn and Te amounts via routine experimentation or optimization.

For all the foregoing reasons, Takahashi would not have provided one of ordinary skill in the art to have selected a Zn and Te bimetal alloy to be present in a recording medium in the amounts recited in claim 12.

Withdrawal of the rejection is respectfully requested.

B. Claims 15 and 16

Claims 15-16 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Takahashi in view of either U.S. Patent No. 6,177,168 ("Stevens") or U.S. Patent No. 4,450,553 ("Holster"). Applicants respectfully traverse this rejection.

For the reasons described above, Takahashi does not describe an optical recording medium as recited in claim 12.

Neither Stevens nor Holster remedy the deficiencies of Takahashi. Stevens and Holster do not describe an optical recording medium comprising an active layer made of inorganic material, presenting a front face for receiving an optical radiation during writing operations, and a rear face wherein the inorganic material is a tellurium and zinc alloy consisting of an atomic percentage of between 60% and 70% of zinc and between 30% and 40% of tellurium as recited in claim 12.

Stevens or Holster alone, or in combination with Takahashi, thus would not have provided one of ordinary skill in the art with a reason or rationale to have selected Zn and Te to be present in a bimetal alloy in the specific amounts recited in claim 12.

Withdrawal of the rejection is respectfully requested.

C. Claims 21-22

Claims 21 and 22 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Takahashi in view of U.S. Patent No. 5,354,590 ("Tamura"). Applicants respectfully traverse this rejection.

For the reasons described above, Takahashi does not describe an optical recording medium recited in claim 12.

Furthermore, Tamura also does not remedy the deficiencies of Takahashi. Tamura does not describe an optical recording medium comprising an active layer made of inorganic material, presenting a front face for receiving an optical radiation during writing operations, and a rear face wherein the inorganic material is a tellurium and zinc alloy consisting of an atomic percentage of between 60% and 70% of zinc and between 30% and 40% of tellurium as recited in claim 12.

Tamura alone, or in combination with Takahashi, Stevens or Holster, would not have provided one of ordinary skill in the art with a reason or rationale to have selected Zn and Te to be present in a bimetal alloy in the specific amounts recited in claim 12.

Withdrawal of the rejection is respectfully requested.

V. Double Patenting


Claims 12-22 were provisionally rejected as allegedly being unpatentable for nonstatutory obvious-type double patenting over claims 12-22 of U.S. Patent Application No. 10/535,411. Applicants respectfully request the rejection be held in abeyance until the present application is in condition for allowance.

VI. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 12-16 and 20-22 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



William P. Berridge
Registration No. 30,024

Jeremy D. Tillman
Registration No. 62,639

WPB:JDT/hs

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OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

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